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10/616,676	07/10/2003	Daniel Charles Birkstrand	ROC920030147US1	2588
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MARTIN & ASSOCIATES, LLC			ZARE, SCOTT A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/616,676	<b>Applicant(s)</b> BIRKESTRAND ET AL.
	<b>Examiner</b> SCOTT A. ZARE	<b>Art Unit</b> 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 July 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-44 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/10/2003, 08/05/2003, 05/09/2005, 04/27/2007, 06/18/2007, 11/10/2007.

4) Interview Summary (PTO-413)

Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_



**DETAILED ACTION**

***Information Disclosure Statement***

The information disclosure statement(s) (IDS) submitted on 07/10/2003, 08/05/2003, 05/09/2005, 04/27/2007, 06/18/2007, and 11/10/2007 are being considered by the examiner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 30 further limits "computer readable signal bearing media" of claim 28 to "transmission media." It is unclear in view of the Specification how a "transmission media" can bear a computer product. For purposes of this Action, "transmission media" is interpreted to mean any media capable of transmitting data.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the program product of claim 28

must be executed by a computer in order to fall within a statutory class. As it now stands, the program product of claim 28 is merely program code stored on a disk. In addition, the limitation "computer readable signal bearing media" can be broadly interpreted to include signals such as carrier waves which do not fall within a statutory category. See, e.g., *In re Nuitjen*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)(slip. op. at 18) ("A transitory, propagating signal like Nuitjen's is not a process, machine, manufacture, or composition of matter.' ... Thus, such a signal cannot be patentable subject matter.") Claims 29-35 depend on claim 28 and therefore acquire the same deficiencies as set forth above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Circenis et al. (US 7,146,496, filed Jan. 23, 2003, referred hereinafter as "Circenis").

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In regard to claim 26-27, Circenis discloses a method for doing business comprising the steps of:

- (1) providing a computer system to a customer, wherein the computer system includes at least one resource that provides metered capacity on demand (see column 5, disclosing temporary capacity in an ICOD computer system, and column 6, lines 14-45, disclosing how temporary capacity is tracked);
- (2) receiving prepayment by the customer for a specified resource-time of the at least one resource (see column 6, lines 46-60, disclosing the current temporary capacity balance);
- (3) enabling the at least one resource (see column 5, lines 35-60, disclosing activating the inactive ICOD components at the request of the user);
- (4) metering actual usage of the at least one resource (see column 6, lines 14-45, disclosing tracking consumption of temporary capacity); and
- (5) deducting the actual usage from the prepaid specified resource-time (see column 6, lines 46-60, disclosing debiting consumption from the current temporary capacity balance).

Circenis additionally discloses the step of disabling the at least one resource when the actual usage is not less than the prepaid specified resource time. (See column 7, disclosing "deactivation").

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-25, 28-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Circenis et al. (US 7,146,496, filed Jan. 23, 2003, referred hereinafter as "Circenis").

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In regard to claim 1, Circenis discloses an apparatus comprising:

- at least one processor (see column 1, lines 30-35, disclosing "the ICOD components may be processors);
- a memory coupled to the at least one processor (see column 5, lines 35-40, disclosing "nonvolatile memory");
- at least one resource coupled to the at least one processor that provides temporary capacity when requested by a user of the apparatus (see column 1, lines 15-60, disclosing "Instant Capacity on Demand" systems); and
- a capacity manager residing in the memory and executed by the at least one processor, the capacity manager managing access to the at least one resource when requested by the user, the capacity manager metering actual use of the at least one resource (see column 2, disclosing "audit system 116").

Circenis does not explicitly disclose *billing* for the actual use. However, Circenis does disclose debiting a user's account. (See column 6, line 45.) It would have been

obvious to one of ordinary skill in the art at the time of the invention to generate and send out a bill rather than debit a prepaid account because these steps are notoriously old and well-known to be interchangeable depending on the preferences of the service provider and the customer (i.e., design choice).

In regard to claim 2, Circenis does not explicitly disclose *generating a bill*.

However, for the same reasons as stated above, generating and sending out a bill is an obvious variation of the invention disclosed in Circenis.

In regard to claims 3-6, Circenis additionally discloses deducting metered resource-time from a prepaid resource-time (see column 6, lines 46-60, disclosing debiting consumption from the current temporary capacity balance), determining whether an enablement code is valid, wherein the enablement code includes a specified resource-time (see column 5, lines 53-67, disclosing a "codeword"), and disabling the at least one resource when the metered actual usage of the at least one resource exceeds a specified resource-time (see column 7, disclosing "deactivation").

In regard to claims 7-13, Circenis discloses the apparatus as described in claims 1-6 which additionally comprises:

- a plurality of logical partitions defined on the apparatus (see column 8, lines 5-15, disclosing that the "ICOD computer system is implemented as a partitionable computer system");
- wherein the capacity manager determines whether a resource is shared, and if so, meters usage of the shared resource above a predetermined non-zero threshold. (See column 10, lines 20-60).

In regard to claims 14-18, Circenis discloses a computer-implemented method for providing metered capacity of at least one temporary resource on demand, the method comprising the steps of:

- enabling the at least one resource for metered operation (see column 6, lines 14-45, disclosing how temporary capacity is tracked);
- metering actual usage of the at least one resource (see column 6, lines 14-45, disclosing tracking consumption of temporary capacity).

Circenis additionally discloses deducting metered resource-time from a prepaid resource-time (see column 6, lines 46-60, disclosing debiting consumption from the current temporary capacity balance), determining whether an enablement code is valid, wherein the enablement code includes a specified resource-time (see column 5, lines 53-67, disclosing a "codeword"), and disabling the at least one resource when the metered actual usage of the at least one resource exceeds a specified resource-time (see column 7, disclosing "deactivation").

Circenis does not explicitly disclose:

- *billing* for the actual usage of the at least one resource.

However, Circenis does disclose debiting a user's account. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a bill rather than debit a prepaid account because these steps are notoriously old and well-known to be interchangeable depending on the preferences of the service provider and the customer.

In regard to claims 19-23, Circenis discloses a computer-implemented method for providing metered capacity of at least one temporary resource on demand (see rejection of claims 14-18) in a computer system that includes a plurality of logical partitions. (See column 8, lines 5-15, disclosing that the "ICOD computer system is implemented as a partitionable computer system.")

In regard to claim 24, Circenis additionally discloses the method of claim 19 further comprising the step of determining whether a resource is shared, and if so, metering usage of the shared resource above a predetermined non-zero threshold (see column 10, lines 20-60).

In regard to claim 25, Circenis discloses a method for doing business comprising the steps of:

- (1) providing a computer system to a customer, wherein the computer system includes at least one resource that provides metered capacity on demand (see column 6, lines 14-45, disclosing how temporary capacity is tracked);
- (2) at the request of the customer, enabling the at least one resource (see column 5, lines 35-60, disclosing activating the inactive ICOD components at the request of the user); and
- (3) metering actual usage of the at least one resource (see column 6, lines 14-45, disclosing tracking consumption of temporary capacity);

Circenis does not explicitly disclose:

- *generating a bill* for metered resource-time.

However, Circenis does disclose debiting a user's account. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a bill rather than debit a prepaid account because these steps are notoriously old and well-known to be interchangeable depending on the preferences of the service provider and the customer (i.e., design choice).

In regard to claim 28, Circenis discloses a program product comprising:

- a capacity manager that manages access to at least one resource in a computer system that provides temporary increased capacity when requested by a user, the capacity manager metering actual use of the at least one resource and billing for the actual use (see column 4, lines 1-30); and
- computer readable signal bearing media bearing the capacity manager (see column 4, lines 1-30, disclosing "a program storage medium having computer readable codes embodied therein").

Circenis does not explicitly disclose:

- *billing for the actual use.*

However, Circenis does disclose debiting a user's account. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a bill rather than debit a prepaid account because these steps are notoriously old and well-known to be interchangeable depending on the preferences of the service provider and the customer (i.e., design choice).

In regard to claims 29 and 30, Circenis discloses the program product of claim 28 wherein the signal bearing media comprises recordable media (see column 4,

lines 1-30, disclosing "a program storage medium") or transmission media (see column 4, lines 1-30, disclosing "a program storage medium").

In regard to claim 31, Circenis does not explicitly disclose:

- *generating a bill* for metered resource-time.

However, Circenis does disclose debiting a user's account. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a bill rather than debit a prepaid account because these steps are notoriously old and well-known to be interchangeable depending on the preferences of the service provider and the customer (i.e., design choice).

In regard to claims 32-35, Circenis additionally discloses deducting metered resource-time from a prepaid resource-time (see column 6, lines 46-60, disclosing debiting consumption from the current temporary capacity balance), enabling the at least one resource before the capacity manager meters the actual use of the at least one resource (see column 5, lines 53-67), and disabling the at least one resource when the metered actual usage of the at least one resource exceeds a specified resource-time (see column 7, disclosing "deactivation").

In regard to claims 36-43, Circenis also discloses the program product as described in the rejection of claims 28-35 wherein the computer system includes a plurality of logical partitions. (See column 8, lines 5-15, disclosing that the "ICOD computer system is implemented as a partitionable computer system.")

In regard to claim 44, Circenis also discloses the program product of claim 36 wherein the capacity manager determines whether a resource is shared, and if so,

meters usage of the shared resource above a predetermined non-zero threshold. threshold (see column 10, lines 20-60).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2002/0178206 (System and method for monitoring computer application and resource utilization)

US 2002/0013802 (Resource allocation method and system for virtual computer system)

US 2005/0125314 (Computer resource usage metering method for network software application, involves providing usage information for service request based on correlated recorded process accounting information and recorded request information)

US 2002/0161891 (System and method for computer resource marketing)

US 2002/0166117 (Method system and apparatus for providing pay-per-use distributed computing resources)

US 2003/0028653 (Method and system for providing access to computer resources)

US 6,584,489 (Method and system for scheduling the use of a computer system resource using a resource planner and a resource provider)

US 2004/0215748 (Method, system, and computer program product for on demand enablement of dormant computing resources)

US 2002/0016842 (Method for charging fee for use of network resources and method and system for allotting network resources)

US 2003/0093528 (Method and system for enabling resource sharing in a communication network having a plurality of application environments)

US 2003/0135580 (Method for using partitioning to provide capacity on demand in data libraries)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT A. ZARE whose telephone number is (571)270-3266. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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January 24, 2008